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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/050,020 | 10/23/2001 | Dawn E. Smith | 1973.PSA | 5578 |

7590 12/03/2003

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| EXAMINER |
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LEE, RIP A

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| ART UNIT | PAPER NUMBER |
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1713

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

cb8

Office Action Summary

Application No.

10/050,020

Applicant(s)

SMITH ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

1-4, 6-10, and 12-20

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12-15, 17-19, and 21-25 is/are rejected.
- 7) ☒ Claim(s) 1, 2, 10, 12, 13 and 16-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7. 6) ☐ Other: _____

DETAILED ACTION

This office action follows a response filed on September 15, 2003. Applicants have amended claims 1, 3, 4, 7, 10, and 14. Claims 5 and 11 were canceled, and new claims 15-20 were added.

The indicated allowability of claim 5 is withdrawn in view of the newly discovered reference, U.S. Patent No. 5,631,079 to Gutman *et al.* Rejections based on the newly cited references follow.

Claim Objections

1. Claims 1, 2, 10, 12, 13, 18, 19, and 20 are objected to because of the following informalities: The claims recite indefinite terms, "at least about," "below about," and "above about." The terms are indefinite because it is not clear where the upper and lower bounds of the limitations set forth in the claims lie exactly. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 10, 12, 13, 18, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite indefinite terms, "at least about," "below about," and "above about." The terms are indefinite because it is not clear where the upper and lower bounds of the limitations set forth in the claims lie exactly. See *Ex Parte Lee* 31 USPQ 1105, 1107 (BPAI 1993).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

~~1-4, 6-10, 12-15~~

5. Claims ~~1-15~~^{1-4, 6-10, 12-15} and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,631,079 to Gutman *et al.*

Gutman *et al.* teaches a pressure sensitive adhesive tape comprised of a substrate with at least one surface bearing an acrylic microparticulate adhesive. The acrylic microparticles are bonded to the substrate by means of a primer containing at least one phenolic resin and at least one rubbery compound (claim 1). Here, the primer would serve as binder for the acrylic microparticles. The phenolic resin may be a phenol-formaldehyde resin (claim 2). The rubbery compound may be butyl rubber, NBR, ABS, SBS, S/EBS, polybutadiene, polyisoprene, SIS, and mixtures thereof (claim 3). According to claim 4, the rubbery compound is a mixture of at least two of the aforementioned polymers. In a particular embodiment, the rubbery compound is a mixture of ABS ($T_g > 110^\circ\text{C}$) and polychloroprene ($T_g = -46^\circ\text{C}$ for *trans*-1,3 polymer) in a 3:1 ratio (claim 5, Example 2).[†] Since the adhesive is used on an adhesive tape, it is removable and repositionable, as recited in the present claims. Moreover, the inventors state, “tapes provide electrical properties with essentially no adhesive transfer (col. 2, line 66 – col. 3, line 1).”

[†] *Polymer Handbook*, 4th Ed. John Wiley & Sons, Inc., 1999; Tecaran ABS, Material Safety Data Sheet; Tangram Technology Ltd, ABS Polymer Data File.

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Allowable Subject Matter

6. Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 16 is drawn to a disposable absorbent garment and claim 17 is drawn to a food contact label, each of which contains the adhesive composition of the instant invention.

Gutman *et al.* teaches use of a conductive adhesive tape (wave solder masking tape) as a mask for manufacture of printed circuit boards. Clearly, the subject matter of claims 16 and 17 is not taught by the prior art. Since the prior art invention has completely different end use, skilled artisan would not have found it obvious to use the adhesive composition disclosed in the prior art for a disposable absorbent garment or for a food contact label. Therefore, subject matter of claims 16 and 17 is not obvious over Gutman *et al.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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December 01, 2003



DAVID W. WU
SUPERVISORY PATENT EXAMINER
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